



B
Jhw
P

PATENT
Docket No. 10799/12

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTORS : John E. THOMPSON et al.
SERIAL NO. : 09/725,019
FILED : 11/29/2000
FOR : DNA ENCODING A PLANT DEOXYHYPUSINE
SYNTHASE, A PLANT EUKARYOTIC INITIATION
FACTOR 5A, TRANSGENIC PLANTS AND A
METHOD FOR CONTROLLING SENESCENCE AND
PROGRAMMED CELL DEATH IN PLANTS
EXAMINER : S. Baum
GROUP : 1638

COMMISSIONER FOR PATENTS
AND TRADEMARKS
P.O. Box 1450
Alexandria VA 22313-1450
Mail stop: Petition

Petition for Reconsideration

Sir:

This is in response to a Decision Refusing Status under 37 C.F.R. § 1.47 (a) dated July 26, 2004. Accordingly, the Petition for Reconsideration is due on or before September 26, 2004.

The Petitions Attorney stated in the decision that "there is no indication in the record that the declaration has been objected to by the Examiner" and accordingly denied the petition under 27 C.F.R. § 1.47(a) as "inappropriate." However, the Examiner in the above-referenced case indicated that the Declaration was faulty in that it claimed priority

to a PCT case. The Examiner indicated this in the Notice of Allowability dated March 23, 2004 (attached hereto at Tab A) and in the Examiner's Amendment dated March 10, 2004 (attached hereto at Tab B). Accordingly the Examiner required a substitute Declaration. Thus, applicants respectfully submit that the Petition under 37 C.F.R. § 1.47(a) was appropriate and request reconsideration of the Decision Refusing Status under 37 C.F.R. § 1.47(a) and entry of such Petition. The facts are set forth in more detail below.

In response to the Examiner's requirement for a substitute Declaration, a substitute Declaration was prepared and sent to the three inventors. The originally filed Declaration (attached hereto at Tab C) was signed by all three inventors (Dr. John E. Thompson, Tzann-Wei Wang, and Dongen Lily Lu). However, Dongen Lily Lu refused to sign the substitute Declaration. A substitute Declaration was sent to Dongen Lily Lu on March 19, 2004. She never returned a signed substitute Declaration. Accordingly, a petition under 1.47(a) was filed with the facts known at that time and the issue fee was paid. In the meantime, in other related cases (with the same inventors and in the same patent family) issue fees became due in addition to substitute Declarations as required by the same Examiner. In these other cases, numerous attempts were made to get Dongen Lily Lu to sign the Declaration. Finally after not signing the Declarations, she informed Dr. Thompson that she no longer wanted to be listed as an inventor. Accordingly, a Declaration was prepared and subsequently signed by Dongen Lily Lu stating that she will not sign the substitute Declaration. In the related cases, in which the Examiner also requested a substitute Declaration for the same reason, a Petition and a Supporting Statement of Facts, along with a Declaration from Dongen Lily Lu was filed along with

the substitute Declaration. A copy of such Petition that was filed in a related case is attached here to at Tab D. The Declaration of Dongen Lily Lu clearly states that she refuses to sign the Declaration and does not wish to join in the application.

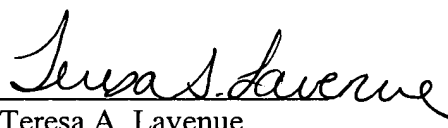
Accordingly, applicant respectfully requests entry of the petition under 1.47(a) filed on June 22, 2004 and requests forwarding the application to the Publication Division for processing into a patent.

CONCLUSION

The Commissioner is authorized to charge any fees relevant to this filing to Deposit Acct No. 11-0600. The Petitions Attorney is invited to contact the undersigned at 202/220-4258 to discuss any matter in this application.

Respectfully submitted,
KENYON & KENYON

Date: 9/16/04


Teresa A. Lavenue
(Reg. No. 47,737)

1500 K Street, N.W.
Washington, D.C. 20005
Telephone: (202) 220-4258
Facsimile: (202) 220-4201

Notice of Allowability

SEP 16 2004

Application No.

09/725,019

Examiner

Stuart F. Baum

Applicant(s)

THOMPSON ET AL.

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to papers filed on 1/6/2004.
2. ☒ The allowed claim(s) is/are 75, 77, 79, 80, 83, 85, 87, 89, 91, 93, 95, 97, 99, 101, and 103 (renumbered 1-15).
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☒ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☒ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date 0304

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 0304
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

Stuart F. Baum

Art Unit: 1638

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.
2. Authorization for this examiner's amendment was given in a telephone interview with Teresa Lavenue on 3/8/2004.

Oath/Declaration

3. The Oath/Declaration is objected to because it claims foreign priority to PCT/US00/18364. It is improper to claim Foreign Priority to a PCT application, because a certified copy cannot be submitted. Correction is requested.

4. IN THE CLAIMS:

Claims 76, 78, 81-82, 84, 86, 88, 90, 92, 94, 96, 98, 100, 102, and 104 have been canceled.

--Claim 75. An isolated antisense polynucleotide [which hybridizes under high stringency conditions with] of SEQ ID NO:11 [or with the complement thereof, wherein the high stringency conditions comprise a 6X SSC hybridization solution, and wherein hybridization is carried out at about 68⁰C; and] wherein said antisense polynucleotide [is capable of inhibiting] inhibits expression of a senescence induced eIF-5A gene comprising SEQ ID NO:11.--

Art Unit: 1638

In claim 101, line 1, a space has been inserted between the number "87" and the recitation "wherein".

Drawings

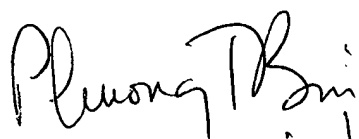
5. Figures 9B, 17, 18, 21 and 22 are objected to because the images are too dark to discern any data. Correction is requested.

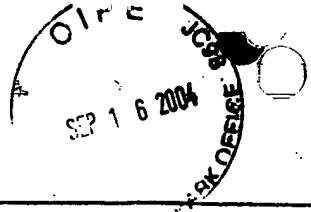
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stuart F. Baum whose telephone number is 571-272-0792. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 571-272-0804. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Stuart F. Baum Ph.D.
Patent Examiner
Art Unit 1638
March 10, 2004


PHUONG T. BUI
PRIMARY EXAMINER 3/17/04



DECLARATION AND POWER OF ATTORNEY

As the below named joint inventors, we hereby declare that:

Our residences, post office addresses and citizenship are as stated below next to our names.

We believe we are an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled DNA Encoding A Plant Deoxyhypusine Synthase, A Plant Eukaryotic Initiation Factor 5A, Transgenic Plants and A Method for Controlling Senescence and Programmed Cell Death in Plants the specification of which (check one):

_____ is attached hereto
or
_____ was filed on June 19, 2000
as United States Application No. 09/597,771
and
_____ was amended on _____

We hereby state that we have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment specifically referred to above.

We acknowledge the duty to disclose information which is material to the patentability of this application, as defined in 37 C.F.R. §1.56.

We acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56, including all material which became available between July 6, 1999, the filing date of prior application Serial No. 09/348,675 (pending) and the filing date of the above-cited Continuation-in-Part application (37 CFR §1.63(d)).

We hereby claim foreign priority benefits under Title 35 United States Code §119(a)-(d) of any foreign application(s) for patent or inventor's certificate, or §365(a) of any PCT international application which designated at least one country other than the United States of America, listed below. We have also identified below any foreign application for patent or inventor's certificate, or any PCT international application having a filing date before that of the application on which priority is claimed.

<u>Appl. Serial No./ Country</u>	<u>Filing Date</u>	<u>Status</u>	<u>Priority Claimed</u>
<u>PCT/US00/18364</u>	<u>07/06/00</u>	_____	<u>Yes: X No: _____</u>

_____ Additional foreign applications are listed on an attached supplemental priority data sheet.

We hereby claim the benefit under Title 35, United States Code §120, of any United States applications or §365(c) of any PCT international application designating the United States of America listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in those prior applications in the manner provided by the first paragraph of Title 35, United States Code §112, we acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, §1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application:

<u>U.S. / PCT Appl. Serial No.</u>	<u>Filing Date</u>	<u>Status/Patent No.</u>	<u>Priority Claimed</u>
09/348,675	07/06/99	Pending	Yes: <input checked="" type="checkbox"/> No: <input type="checkbox"/>

____ Additional U.S. / PCT applications are listed on an attached supplemental priority data sheet.

We hereby claim the benefit under Title 35, United States Code §119(e), of any United States provisional applications listed below :

<u>Application Number</u>	<u>Filing Date</u>

And we hereby appoint:

Richard L. DeLucia

Elizabeth Gardner

Judith L. Toffenetti

Jennifer L. King

Registration No. 28,839

Registration No. 36,519

Registration No. 39,048 and

Registration No. P-46,828

our attorneys, with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith.

Please address all communications regarding this application to:

Jennifer L. King

KENYON & KENYON

1500 K Street, N.W.

Washington, DC 20005

Direct all telephone calls to:

Jennifer L. King

at (202) 220-4363

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

First Inventor : John E. THOMPSON
Inventor's Signature : John Thompson
Date : Sept 28/00
Residence : 640 Woolwich Street
Waterloo, Ontario N2J 4G8, CANADA
Citizenship : citizen of CANADA
Post Office Address : same as above

Second Inventor : Tzann-Wei WANG
Inventor's Signature : Tzann-Wei Wang
Date : Sep 28/00
Residence : 300 Regina Street North, Apartment 1-1109
Waterloo, Ontario N2J 3B8, CANADA
Citizenship : citizen of TAIWAN
Post Office Address : same as above

Third Inventor : Dongen Lily LU
Inventor's Signature : Dongen Lily LU
Date : Oct. 6/2000
Residence : 100 Seagram Drive
Waterloo, Ontario N2L 3B8
Citizenship : citizen of CANADA
Post Office Address : same as above

DC332511v1